

REMARKS/ARGUMENTS

1. The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. (U.S. Patent No. 5,787,231) in view of Hutchins (U.S. Patent No. 5,384,893) and Page et al. (U.S. Patent No. 6,175,821). Claims 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutchins in view of Chang et al. (U.S. Patent No. 6,088,666). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. ("Johnson") in view of Hutchins, Page et al. ("Page") and Chang et al. ("Chang"). Claims 7, 8 and 16-20 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. Claims 1-3 and 7-12 were objected to under 37 C.F.R. § 1.75(a) because the meaning of the phrase "the word" requires clarification. The specification was also objected to as failing to provide proper antecedent basis for the subject matter recited in claim 7. The Examiner further indicated that claims 10-15 would be allowable if rewritten to overcome the claim objections and to include all of the limitations of their respective base claims and any intervening claims. Lastly, the Examiner indicated that claim 16 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, first paragraph. Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein.

Rejections under 35 U.S.C. § 112, first paragraph

2. Claims 7, 8 and 16-20 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. In particular, the Examiner asserts that claims 7, 8 and 16 recite a method in which two sound files or combinations of sound files are played for a particular word.

With respect to claim 7, Applicants have herein amended the claim to compare a second word of the sentence to the list of homographs, thereby avoiding any suggestion that multiple sound files and/or combinations of sound files are played for the same word.

With respect to claim 8, Applicants have herein amended claim 1 to include the limitations of claim 8, thereby essentially re-writing claim 8 in independent form. In addition, claim 1 has been amended to adopt the “compared word” terminology consistent with the Examiner’s interpretation of the claim (see Office Action, p. 3, line 3). Further, claim 1 has been amended to clarify the claimed method in connection with the subject matter of claim 8. In particular, according to amended claim 1, if a compared word is not on the list of pre-recorded words and includes a number, the compared word is audibly spelled out. Alternatively, if the compared word is not on the list of pre-recorded words and does not include a number, the compared word is divided into diphones and combined sound files are played corresponding to the diphones. Further, if the compared word is on the list of pre-recorded words, the word’s sound file is played. Thus, pursuant to amended claim 1, only one sound file, combination of sound files, or audible spelling plays for a particular word as is clearly disclosed in the specification. Applicants apologize for any confusion that may have resulted as it was never their intent to suggest that more than one sound file, combination of sound files, or audible spelling was to play for any particular word in a sentence.

With respect to claim 16, Applicants respectfully disagree with the Examiner’s assertions. In particular, the Examiner asserts that “only a comparing step” results in the event that the word being analyzed is not on the list of homographs. Such an assertion is incorrect. Rather, original claim 16 further states that:

“in the event that the first word is not on the list of pre-recorded words,
dividing the first word into a plurality of diphones,
combining sound files corresponding to the plurality of diphones, and
playing the combined sound files; and

in the event that the first word is on the list of pre-recorded words, playing a
sound file corresponding to the first word, the sound file being independent of the sound
files corresponding to the plurality of diphones.”

Thus, as is clear from the claim, if the analyzed word is not on the list of homographs, the word is compared to a list of pre-recorded words and then either divided into diphones and

played as a combined sound file or played as a diphone-independent sound file depending on whether or not the word is on the list of pre-recorder words.

The Examiner also asserts that original claim 16 requires playing a sound file if the analyzed word is on the list of homographs and playing one of a combined sound file or a sound file corresponding to the word depending on whether the word is on the list of pre-recorded words. Such an assertion is also incorrect because playing one of a combined sound file or a sound file corresponding to the word only ever occurs pursuant to claim 16 if the word is not on the list of homographs. That is, the combined sound files may be played only when the word is not on the list of pre-recorded words. Similarly, the sound file corresponding to the word is only played if the word is on the list of pre-recorded words. However, to ever even get to the step of comparing the word to the list of pre-recorded words, the word must have not been on the list of homographs. Thus, the scenario painted by the Examiner in which one sound file is played because the word is on the list of homographs and another sound file or combination of sound files is played for the same word because the word is or is not on the list of pre-recorded words does not exist under the recitations of claim 16.

Nevertheless, for the sake of further clarification, Applicants have herein amended claim 16 to state that the combined sound files are played in the event that the word being analyzed is both not on the list of homographs and not on the list of pre-recorded words. In addition, claim 16 has been amended to state that the diphone-independent sound file corresponding to the analyzed word is played if the word is not on the list of homographs, but is on the list of pre-recorded words.

With respect to claim 17, such claim has been amended herein to clarify that the analyzed word is audibly spelled out instead of being divided into diphones if the word includes a number and is not on the list of pre-recorded words. Thus, as amended, claim 17 does not contemplate audibly spelling a word and playing combined sound files. As a result, such claim is fully supported by Applicants' specification.

With respect to claims 18-20, such claims were rejected solely based on their dependency upon claim 16, which claim has been shown above to comply with the requirements of 35 U.S.C. § 112, first paragraph.

Therefore, in view of the foregoing arguments and amendments to claims 1 and 7, Applicants submit that claims 1, 7, and 16-20 are fully supported by Applicants' originally filed specification at least in FIG. 1 and the text on pages 12 and 13 that describe such figure. As a result, claims 1, 7 and 16-20 comply with the requirements of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw his rejection of claims 1, 7, and 16-20 under 35 U.S.C. § 112, first paragraph, and pass such claims to allowance.

Rejections under 35 U.S.C. § 103(a)

3. Claims 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Hutchins and Page. Applicants disagree with the Examiner's characterization of said claims in view of the disclosures of Johnson, Hutchins, and Page. Nevertheless, without prejudice to re-filing claims 1-3 in a subsequent continuation application, Applicants have amended claim 1 to incorporate the recitations of claim 8. The only rejection set forth with respect to claim 8 was a rejection under 35 U.S.C. § 112, first paragraph, which rejection was overcome above. Therefore, Applicants submit that claim 1, as amended, is in proper condition for allowance and respectfully request that claim 1 be passed to allowance.

Claims 2 and 3 depend upon claim 1, which claim has been shown allowable above. Therefore, since claims 2 and 3 each introduce additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicants respectfully submit that claims 2 and 3 are in proper condition for allowance.

4. Claims 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hutchins in view of Chang. Applicants disagree with the Examiner's characterization of said claims in view of the disclosures of Hutchins and Chang. Nevertheless, without prejudice to re-filing claims 4-6 in a subsequent continuation application, Applicants have herein amended claim 4 to incorporate the recitations of claim 13, thereby essentially re-writing claim 13 in independent form. The Examiner indicated that claim 13 was allowable if re-written in independent form. Accordingly, Applicants submit that claim 4 is now in proper condition for allowance and respectfully request that claim 4 be passed to allowance.

Claims 5 and 6 depend upon claim 4, which claim has been shown allowable above. Therefore, since claims 5 and 6 each introduce additional subject matter that, when considered in the context of the recitations of claim 4, constitutes patentable subject matter, Applicants respectfully submit that claims 5 and 6 are in proper condition for allowance.

5. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Hutchins, Page and Chang. Applicants disagree with the Examiner's characterization of said claim in view of the disclosures of Johnson, Hutchins, Page, and Chang. Nevertheless, without prejudice to re-filing claim 9 in a subsequent continuation application, Applicants have herein amended claim 9 to incorporate the recitations of claims 1 and 10, thereby essentially re-writing claim 10 in independent form. The Examiner indicated that claim 10 was allowable if re-written in independent form. Accordingly, Applicants submit that claim 9 is now in proper condition for allowance and respectfully request that claim 9 be passed to allowance.

Objections to the Claims

6. Claims 1-3 and 7-12 were objected to under 37 C.F.R. § 1.75(a) because the meaning of the phrase "the word" requires clarification. Applicants have herein cancelled claims 8 and 10 and amended claims 1-3, 7, 9, 11, and 12 to incorporate the "compared word" terminology referenced by the Examiner (see Office Action, p. 3, lines 2-3) or otherwise clarify said claims as requested by the Examiner (see, e.g., claim 7). Accordingly, Applicants submit that claims 1-3, 7, 9, 11, and 12 comply with 37 C.F.R. § 1.75(a) and are now in proper condition for allowance.

Objections to the Specification

7. The specification was objected to as failing to provide proper antecedent basis for the subject matter recited in claim 7. As detailed above, Applicants have amended claim 7 to compare a second word of the sentence to a list of homographs while maintaining the claim's dependency upon claim 1. With such amendment, there is no longer any possible confusion as to whether the "compared word" of claim 1 is played in claim 1 and then again in claim 7. Rather

the “compared word” is addressed in claim 1, but not in claim 7. Rather, claim 7 refers to another compared word (i.e., a so-called “second word”). However, since claim 7 depends upon claim 1, which claim is essentially claim 8 in independent form with appropriate corrections to overcome the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, the introduction of the “second word” does not require any further search or consideration because it is a dependent limitation to an allowed independent claim. Applicants’ original specification clearly discloses that all the words of the sentence are preferably compared, one at a time, to the list of homographs in accordance with the logic flow of FIG. 1. Thus, Applicants amendment to claim 7 is fully supported by Applicants’ specification. Therefore, Applicants respectfully request that the Examiner withdraw his objection to the specification.

Allowed Claims

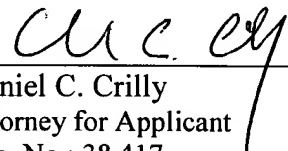
8. The Examiner indicated that claims 10-15 would be allowable if rewritten to overcome the claim objections and to include all of the limitations of their respective base claims and any intervening claims. Applicants have herein amended claim 9 to include the limitations of claims 1 and 10, thereby essentially re-writing claim 10 in independent form, as well as incorporating the “compared word” terminology suggested by the Examiner to overcome the objections to claim 10. Applicants have also re-written claims 11, 12, 13 (by amendment of claim 4), 14 and 15 in independent form to include all of the limitations of their respective base claims and any intervening claims and to overcome the claim objections. As a result, Applicants submit that claims 4, 9, 11, 12, 14, and 15 are in proper condition for allowance.

9. The Examiner further indicated that claim 16 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, first paragraph. As detailed above, Applicants disagree with the Examiner’s rejection of claim 16, but nevertheless have amended the claim in an effort to clarify the claim to avoid a construction as employed by the Examiner. Accordingly, Applicants submit that claim 16 is in proper condition for allowance. In addition, claims 17-20 depend upon claim 16, which claim has been shown allowable above. Therefore, since claims 17-20 each introduce additional subject matter that, when considered in the context of the

recitations of claim 16, constitutes patentable subject matter, Applicants respectfully submit that claims 17-20 are in proper condition for allowance.

10. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

By: 
Daniel C. Crilly
Attorney for Applicant
Reg. No.: 38,417
BRINKLEY, MCNERNEY,
MORGAN, SOLOMON & TATUM, LLP
200 East Las Olas Blvd., Suite 1900
Ft. Lauderdale, FL 33301
Phone: (954) 522-2200/Fax: (954) 522-9123
Email: daniel.crilly@brinkleymcnerney.com



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A handwritten signature in black ink, appearing to read "Chriselide Mendez", written over a horizontal line.

Chriselide Mendez, Legal Assistant

November 16, 2004

Date